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Paper No. 5

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OFFICE OF PETITIONS

In re Application of :
Li, Mao, and Leong :
Application No. 09/750,779 : DECISION REFUSING STATUS
Filed: 2 January, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 12013/55202 :
:

This is in response to the petition filed under 37 CFR 1.47(a) on 14 September, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 2 January, 2001, without an executed oath or declaration. Accordingly, on 14 February, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration and a surcharge for its

late filing. In reply, on 14 September, 2001, petitioners filed, *inter alia*, a request and the fee for a five (5) month extension of the time for reply to the Notice to File Missing Parts, accompanied by the present petition and petition fee, and a declaration naming Wei-Ping Li, Hal-Quan Mao, and Kam W. Leong as joint inventors and signed by joint inventors Li and Mao on behalf of themselves and joint inventor Leong.

Petitioners assert that joint inventor Leong was sent a copy of the declaration, but failed to sign and return it.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2). In regards to item (1), petitioners have not submitted sufficient evidence to prove that a copy of the application was sent or given to the non-signing inventor. The petition states that a copy of the power of attorney, a declaration, and an assignment for the present application was sent to Leong, but there is no showing that a copy of the application papers (specification, including claims, drawings, if any, as well as the declaration) was ever sent or given to Leong. Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Petitioners must also present proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

With regard to item (2), the declaration filed with the petition is defective in that it does not list the citizenship for each inventor. The copy of the declaration signed by Li does not list the citizenship of Mao and Leong, and the copy signed by Mao does not list the citizenship for Li and Leong. Additionally, the declaration signed by Mao lacks the residence and mailing address of Li. Petitioners must show that a complete declaration containing the requisite information for each joint inventor was signed by or presented for signature to the respective inventors. A new oath or declaration in compliance with 37 CFR 1.63 and 1.64 must be submitted with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy